

### REMARKS

This application has been carefully reviewed in light of the Office Action dated September 28, 2004. Claims 20 and 25 to 31 are now pending in the application, with Claims 1 to 19 and 21 to 24 having been cancelled, and Claims 25 to 31 having been newly-added. Claims 20 and 28 are the independent claims. Reconsideration and further examination are respectfully requested.

The drawings were objected to for allegedly not depicted various features claimed in Claim 19. Without conceding the correctness of the objection, Claim 19 has been cancelled, thereby obviating the objection. Accordingly, withdrawal of the objections to the drawings is respectfully requested.

Claims 19 and 20 were rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. More specifically, various features claimed in Claim 19 were alleged as not having been described in the specification. Again, without conceding the correctness of the rejection, Claim 19 has been cancelled, thereby obviating the rejection. Accordingly, withdrawal of the § 112, first paragraph, rejection is respectfully requested.

Claims 19 and 20 were also rejected under 35 U.S.C. § 112, second paragraph. As the rejections relate to Claim 19, again, without conceding the correctness of the rejection, Claim 19 has been cancelled, thereby obviating the rejection. As the rejections relate to Claim 20 (alleged lack of antecedence), that claim has been amended as deemed appropriate giving due consideration to the points noted in the Office Action. In view of the foregoing, withdrawal of the § 112, second paragraph, rejection is respectfully requested.

Claims 19 and 20 were rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0038348 (Malone). Reconsideration and withdrawal of the rejection are respectfully requested.

The present invention concerns online shopping for consumable goods. According to the invention, a status of use is received of at least one consumable used in a printing device via a communication line. A service point is calculated according to the received status of the use, and when a customer purchases merchandise provided by a consumable trader based on the calculated service point, the service and the consumable trader are registered in relation to each other. Then, compensation to the consumable trader is decided based on the service registered in relation to the consumable trader. (See, for example, page 172, line 1 to page 186, line 7 of the subject specification.)

Referring specifically to the claims, amended independent Claim 20 is an online shopping method executed in a system having a server function of controlling a status of use of at least one consumable used upon printing in a printing device, the method comprising a reception step of receiving the status of the use of the at least one consumable used in the printing device via a communication line by the server function, a calculation step of calculating a service point according to the status of the use of the at least one consumable received in the reception step, a relation registration step of, when a customer purchases merchandise provided by a consumable trader on a service based on the service point calculated in the calculation step via a predetermined purchase screen, causing a storage portion to register the service and the consumable trader in relation to each other, and a compensation decision step of deciding a compensation to the consumable trader based on the service registered in relation to the consumable trader in the relation registration step.

Newly-added Claim 28 is a system claim that substantially corresponds to Claim 20.

The applied art is not seen to disclose or to suggest the features of Claim 20 and 28, and in particular is not seen to disclose or to suggest at least the feature of calculating a service point according to a received status of use of at least one consumable, when a customer purchases merchandise provided by a consumable trader on a service

based on the calculated service point, causing a storage portion to register the service and the consumable trader in relation to each other, and deciding a compensation to the consumable trader based on the service registered in relation to the consumable trader.

Malone is merely seen to disclose a network architecture for a globally accessible network (Internet) so as to facilitate access to information (i.e., searching the Internet for information) located at different server sites. The system of Malone can be used in e-commerce applications. However, Malone is not seen to disclose or to suggest anything with regard to calculating a service point based on received status use information of at least one consumable, or that when a customer purchases merchandise provided by a consumable trader on a service based on the calculated service point, a storage portion registers the service and the consumable trader in relation to each other, and deciding a compensation to the consumable trader based on the service registered in relation to the consumable trader. Thus, Malone is not seen to disclose or to suggest the features of the present invention.

It is noted that the Office Action merely made a bald assertion that the claimed process is “common knowledge” that would have been obvious to include in Malone’s Internet communication system. However, the Office Action must provide factual evidence to support such a conclusion of “common knowledge” and therefore, the rejection fails to meet the legal requirements to show obviousness under 35 U.S.C. § 103(a). In this regard, as correctly stated at MPEP 2144.03: “It is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based.” citing *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002); *In re Zurko*, 258 F.3d 1379, 1385, 15 USPQ2d 1693, 1697 (Fed. Cir. 2001)(holding that general conclusions concerning what is “basic knowledge” or “common knowledge” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings

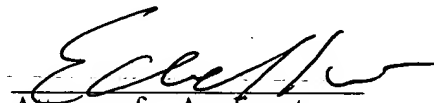
will not support an obviousness rejection.) Thus, the grounds for the rejection are improper and the rejection should be withdrawn.

In view of the foregoing amendments and remarks, Claims 20 and 25 to 31 are believed to be allowable.

No other matters having been raised, the entire application is believed to be in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience.

Applicant's undersigned attorney may be reached in our Costa Mesa, California office by telephone at (714) 540-8700. All correspondence should continue to be directed to our address given below.

Respectfully submitted,



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